

Application Serial No.: 10/092,319  
Filing Date: 03/06/2002

Reply to Office action of: 05/04/2005  
Attorney Docket No.: YOR920010754US1

### **REMARKS**

Applicants respectfully submit that all the claims presently on file are in condition for allowance, which action is earnestly solicited.

### **THE CLAIMS**

#### **CLAIMS REJECTION UNDER 35 USC 112, SECOND PARAGRAPH**

Claims 13, 14-15 were rejected under 35 U.S.C. 112, second paragraph as containing certain informalities. The claims have now been amended in satisfaction with 35 USC 112.

#### **CLAIMS REJECTION UNDER 35 USC 101**

Claims 18-34 were rejected under 35 U.S.C. 101 on the ground that the claimed invention is directed to non-statutory subject matter. The claims on file have now been amended in satisfaction with 35 USC 101.

#### **CLAIMS REJECTION UNDER 35 USC 102**

Claims 1-12, 14-28, 30-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Boucher et al. (U.S. Pat. No. 5,884,246), hereinafter referred to as "Boucher". Applicants respectfully submit that Boucher does not disclose all the elements and limitations of the claims on file. Consequently, the present claims are not anticipated under 35 U.S.C. 102, and the allowance of these claims is earnestly solicited. In support of this position, Applicants submit the following arguments:

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#### **A. Legal Standard for Lack of Novelty (Anticipation)**

The standard for lack of novelty, that is, for "anticipation," is one of strict identity. To anticipate a claim for a patent, a **single prior source must contain** all its essential elements, and the burden of proving such anticipation is on the party making such assertion of anticipation. Anticipation cannot be shown by combining more than one reference to show the elements of the claimed invention. The amount of newness and usefulness need only be minuscule to avoid a finding of lack of novelty.

The following are two court opinions in support of Applicants' position of non anticipation, with emphasis added for clarity purposes:

- "Anticipation under Section 102 can be found only if a reference shows **exactly** what is claimed; where there are **differences** between the reference disclosures and the claim, a rejection must be based on obviousness under Section 103." *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985).
- "**Absence** from a cited reference **of any element** of a claim of a patent negates anticipation of that claim by the reference." *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986), on rehearing, 231 USPQ 160 (Fed. Cir. 1986).

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### **B. Brief Summary of the Present Invention**

Prior to presenting substantive arguments in favor of the allowability of the claims on file, it might be desirable to summarize the present invention. The present invention relates in general to the field of data management, and particularly to a workflow. More specifically, this invention relates to a system and associated method for the implementation of a **dynamic email notification with attachments in different languages.**

A dynamic email notification is a specialized, en masse category of email designed to reach a large number of administrators, customers, and/or vendors, to purvey notices, such as corporate news bulletins, changes in sales orders, events of item deletions, and critical news bulletins or messages about new product offerings.

With the widespread international use of the Internet and email, it has become necessary to concurrently address versatile audiences in several countries, or even the entire world. To this end, the notices need to be language-specific to the target audience.

The present sends a language-specific email and attachments to any worldwide email address via the Internet. One implementation of the present invention is a process where, for example, a sale order includes several line items. Typically, customers provide their email addresses while entering the sales order, which are in turn entered on a particular text field in the sales order line items. The **customer can enter different email addresses for different line items.** An email is sent to an address specified in the sale order line item text field.

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**As used herein, "dynamic" refers to the non-static (or fixed) content of the email.** The advantages of the present dynamic email notification system are numerous, among which are the following:

- Immediate customer receipt of important business documents, such as the Installation Service information agreement.
- Automated multi-language specific communication with one world wide design / implementation.
- World Wide Internet communication using the existing infrastructure.
- Customer satisfaction of receiving necessary information on a timely basis, in the communication language that the customer requested.
- Many different dynamic e-mails, in different languages, can be sent to multiple different e-mail addresses for one event instance. The necessary and relevant information for the particular recipient, are populated in the document and sent to the requested address for the particular type of material(s).

### **C. Independent Claims 1 and 18 in Light of Boucher**

Applicants will now present arguments in support of the allowance of independent claims 1 and 18, and the claims dependent thereon, over Boucher. Claim 1, as a representative claim, recites elements that are not described in Boucher.

Boucher generally describes a translation system that provides transparent translation of electronically transmitted messages. The emphasis of Boucher is on providing translation services. The translation services could be used in conjunction with the present system but not to supplant the present system.

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More specifically, according to the present invention the line items of the document to be forwarded are parsed to automatically identify the destination address and from which to determine the specific language in which the message and attachment are to be sent. Once the specific language is determined, then Boucher's system could be used to provide the translation to the specific language of the destination address.

The office action rejected claim 1 in view of Boucher's teaching, reasoning that "Boucher teaches translating emails, col. 3, lines 28-38. Boucher teaches parsing a document to retrieve variable data related to a destination language, col. 11, lines 44-46."

Applicants respectfully submit that Boucher, column 11, lines 44 - 46, does not teach parsing the line items of the document to determine the language to be used. Rather, Boucher states that: "In accordance with the present invention, the translation machine identifies the language of the message to be translated (Step 228 in FIG. 3C). Either available techniques or readily arrived at techniques can be used to identify the language of the message." (Emphasis added).

In other terms, Boucher vaguely states that the identification of the language is determined by some unidentified method, and does not explain the details of this method. It should be emphasized that the present invention provides a dynamic and automatic method to determine the destination language, based specifically on parsing the line items of the document.

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As explained in the instant specification and the Summary of the Invention provided above, if the parsed line items specify more than one destination language, then the present system sends the related document and attachments in numerous destination-specific languages. Boucher does not support such a service.

In addition, it is Applicants' understanding that Boucher translates all the documents and does not describe parsing the line items of the document to determine if a dynamic task is required; and, if a dynamic task is required, then selecting the specific language to be used. More specifically, if the present system determines that a dynamic task is not required, then translation to the destination language is not required as the document and the attachment will be sent in the language of the origin source.

The office action further states that "Boucher teaches based on the parsed data selecting a destination language for the email and attachments, col. 11, lines 60-62; col. 9, line 45." The cited excerpts are reproduced herein: "It is also preferred that the translation machine 136 determines the language which the message is to be translated into (Step 230 in FIG. 3C)." And "... files often associated with an e-mail message and referred to as "attachment."

As presented earlier, Boucher (i.e., the translation machine 136) determines the translation language by some vague method, without specifying the details of this method. Boucher does not use the parsed data of the line items to determine the translation language.

The office action states, regarding claims 2 and 19 that "Boucher teaches

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sending emails to two addresses in two different languages col. 13, lines 5-12." Applicants respectfully submit that claims 2 and 19, as amended, clarify that the two or more destination addresses are determined from two or more line items. Boucher does not describe the details of this implementation.

As a result, based on the legal authorities above, Boucher does not anticipate independent claims 1 and 18 and the claims dependent thereon. The claims on file are thus allowable, and the allowance of these claims is respectfully requested.

### **CLAIMS REJECTION UNDER 35 USC 103**

Claims 13 and 29 were rejected under 35 U.S.C. 103(a) as being unpatentable over Boucher, reasoning that: "the Boucher patent discloses the method of the preceding claims. The Boucher patent does not explicitly disclose the data relating to a pdf document. However, Official Notice is taken MPEP 2144.03 (a)) that using pdf documents is well known in the art to insure diverse communication capability. It would have been obvious to one of ordinary skill in the art at the time of the application's invention to use a pdf document to obtain the advantages of communicating with compatible forms of data. By the above rational, the claim is rejected."

Applicants agree with the Examiner that the use of pdf documents was known prior to the filing of the patent application. However, Applicants respectfully submit that the feature recited in claims 13 and 29, as amended, in combination with the features of the allowable independent claims 1 and

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18 upon which claims 13 and 29 respectively depend, is allowable, for the response discussed above.

### **CONCLUSION**

All the claims presently on file in the present application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned at the below-listed telephone number.

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Respectfully submitted,



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